

II. Double Patenting Rejections

Claims 1-102 were rejected in the Office Action of April 11, 2001 under 35 U.S.C. § 101 as claiming the same invention as that of claims 1-3, 6, 9 and 23-32 of prior U.S. Patent No. 6,056,945. Applicant acknowledges, with appreciation, the withdrawal of this rejection in the final Office Action dated October 23, 2001.

Applicant also thanks the Examiner for clarifying the provisional double patenting rejection of claims 1-102, which were rejected over claims 1-76 of copending application no. 09/662,796, and for indicating that the provisional rejections will be held in abeyance until allowable subject matter is indicated.

III. Rejection under 35 U.S.C. 112

The Examiner has maintained the rejection of claims 1-102 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. According to the Examiner,

The terms 'derivatives' and 'carbon based unsaturated compounds' are still vague and indefinite. For example, in claim 8, what are encompassed by the phrases 'derivatives of linear C1-C40 alkyls, derivatives of branched C3-C40 alkyls...derivatives of polyalkylene glycols'? The vast number of compounds encompassed by these phrases is innumerable. Thus, the specification does not define all these compounds and one of ordinary skill in the art would not be appraised of them. Office Action dated October 23, 2001 at page 3, lines 6.

Applicant respectfully disagrees, and continues to traverse this rejection for reasons of record and those discussed below.

As emphasized by M.P.E.P. § 2173.04, "[b]readth of a claim is not to be equated with indefiniteness. If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a

scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph."

In view of the standard for determining indefiniteness outlined in the M.P.E.P., Applicant respectfully submits that the Examiner's reasoning is misplaced. Rather, the scope of the subject matter of the claims is clear to one of ordinary skill in this art who would know and understand the terms used in the claims, and thus the subject matter embraced by the claims. Moreover, Applicant clearly defined and cited support in the specification for the term "derivative" and the phrase "carbon based unsaturated compounds" in the response dated September 18, 2001 at pages 6-7. In view of this rejection being maintained, one can objectively conclude that the Examiner has ignored the support cited by Applicant in the September 18 response, which is contrary to the procedure outlined in the M.P.E.P. It is well established that "during examination, the pending claims must be given the broadest reasonable interpretation consistent with the specification." M.P.E.P. § 2173.05(a) (emphasis added). As the Examiner has failed to do so in the present case, Applicant respectfully requests that the rejection be withdrawn for at least the foregoing reasons.

IV. Rejection under 35 U.S.C. 103(a)

The Examiner has maintained the rejection of claims 1-102 under 35 U.S.C. 103(a) as being unpatentable over Blankenburg et al. (WO 99/04750) in view of Myers et al. (WO 94/12148). Respectfully, Applicant disagrees for at least the reasons cited in the response dated September 18, 2001, at pages 7-10, and for the additional reasons set forth below.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

First, Applicant respectfully points out, as emphasized in the Response dated September 18, 2001, at page 9, the compositions in both prior art references are separate and distinct from the present invention. For example, Blankenburg does not teach a composition that comprises both (a) at least one silicone/acrylate copolymer and (b) at least one nonionic polymer comprising at least one vinyl lactum unit. See instant claim 1 and Response dated September 18, 2001, at page 9, paragraph 1. The Examiner relies on Myers to remedy the deficiencies in Blankenburg. However, even though Myers may teach polyvinyl lactam polymers, Myers does not teach or suggest the use of polyvinyl lactam polymers is effective with all types of hair spray compositions. Rather, Myers is only concerned with a hair spray formulation that must include sulfo-polyesters in order for it to be effective. For example, Myers specifically teaches:

It is unexpected, based on the prior art, that the combination of sulfo-containing water dispersible polyester having a Tg of 36°C to 40°C with a water soluble vinyl polymer would give aerosol hair spray formulation improvements over either of the single component system or a dual component system at other glass transition temperatures, particularly in washability/rinsability, tackiness, humidity resistance and film elasticity. Page 9, lines 24-32.

At best, Myers teaches that improved properties are not associated with a soluble vinyl polymer, per se, but with the combination of that vinyl polymer with a particularly defined sulfo-containing water dispersible polyester, i.e., one having a Tg of 36°C to 40°C. It is unreasonable to extrapolate Myers' teaching of a combination of polymers that is fundamentally different, not only from the claimed polymers, but also from those taught

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

in Blankenburg, as a teaching that the claimed vinyl lactam unit would have been obvious.

In view of the many deficiencies described above, it appears that, with the aid Applicant's specification as a template, the Examiner has plucked individual teachings from different sections of the references to piece together and reconstruct the claimed invention - the essence of improper hindsight reconstruction. The Federal Circuit has recently held that "it is improper, in determining whether a person of ordinary skill would have been led to [a] combination of references, simply to use that which the inventor taught against its teacher." *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002) (citations omitted). Accordingly, the rejection should be withdrawn for this reason alone.

Secondly, since the prior art references relied on by the Examiner do not teach or suggest the claimed compositions, they certainly do not teach, suggest, or give any significance to the properties associated with the claimed compositions. Specifically, as discussed on page 2, lines 2-19 of the instant specification, the present invention is distinguishable over the prior art for reasons that include the discovery that the combination of silicone/acrylate copolymers and nonionic polymers comprising at least one vinyl lactam unit results in compositions having a resistance to a powdering effect. Accordingly, Applicant respectfully submits that Blankenburg in view of Myers, in addition to the reasons cited in the Response dated September 18, 2001, are non-analogous, as they are deficient with respect to the properties of the claimed invention.

In particular, Blankenburg, in its disclosure of a method for producing water soluble and dispersible polymers for cosmetic formulations, teaches that the synthetic polymers disclosed therein are useful primarily for setting hairstyles (see page 2, first

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

not
bound
to preferred
embodiments

paragraph of translated copy), having good film properties (see Table 1, page 22). Myers, in its disclosure of hair spray formulations, teaches a polymeric material that maintains hair in a desired arrangement, with consistency and firm texture (see page 1, lines 23-27), and formulations with excellent storage stability (see page 3, lines 29-31). Each reference, however, is completely silent with respect to improved properties associated with the claimed combination of components. Indeed, as shown in Myers, improved properties are a function of fundamentally different, and narrowly defined, polymers.

Moreover, as the Office is aware, the motivation to modify or combine the prior art must flow from some teaching in the art that suggests the desirability or incentive to make the modification or combination needed to arrive at the claimed invention. See, e.g., *In re Napier*, 34 U.S.P.Q.2d 1782, 1784 (Fed. Cir. 1995) (emphasis added). As shown and discussed *supra*, however, Blankenburg in view of Myers clearly does not suggest the desirability to be combined, as they are not concerned with the properties of the present invention. As such, the Examiner has merely used hindsight wisdom, based on the Applicant's invention to defeat patentability, which is incorrect. See, e.g., *In re Dembiczak*, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999). Accordingly, the rejection should be withdrawn for this additional reason.

Furthermore, the Federal Circuit recently clarified and set-forth the proper standard for motivation in combining references. Specifically, the Federal Circuit asserted that:

[t]he factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record . . . This factual question of motivation is

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

material to patentability, and could not be resolved on subjective belief and unknown authority . . . the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion.

See, e.g., *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002) (citations omitted) (emphasis added). The Examiner has directly contravened the decision in *In re Lee*. In particular, the Examiner has not at least made the requisite factual determination whether to combine the references and has not based the inquiry on objective evidence of record. Accordingly, for all of the foregoing reasons, the Examiner has failed to make a *prima facie* case of obviousness, and therefore Applicant requests that the rejection be withdrawn.

V. Conclusion

In view of the foregoing remarks, Applicant requests reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: March 19, 2002

By: Bryant Young (Reg. No. 49,073) for
Louis M. Troilo
Reg. No. 45,284

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com